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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/657,627

09/08/2003

Joon Keun Lee

434/1/004

1539

170 7590 01/23/2008
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EXAMINER

HOFFMANN, JOHN M

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

01/23/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<div style="border: 1px solid black; width: 150px; height: 20px; margin: 0 auto;"></div> <p style="text-align: center;">Office Action Summary</p>	Application No. 10/657,627	Applicant(s) LEE ET AL.	
	Examiner John Hoffmann	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/28/2007 has been entered.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the optical fiber standard value controller unit adapted to control standard values must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering

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of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

Claim Rejections - 35 USC § 103

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 and 3-6 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida 6519404 in view of Askins H1268, Butterworth-Heinemann and Sclater et al and optionally in view of Pereman 5049178.

See the prior Office action for the manner in which Yoshida, Askins, Butterworth-Heinemann and Sclater were applied. Pereman can also be applied as evidence that it is known in the glass manufacturing art to use two brackets (instead of one) so as to gain independent operation (See Pereman 5049178). Thus, it would have been obvious to one of ordinary skill in the glass art to provide each wheel on its own bracket for the advantage of permitting individual adjustment.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 3-6 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "standard values" is indefinite as to its meaning. The term is not defined in the specification. Nor is there any description nor is there any identified examples. At most there is only one mention of a specific standard; page 2, line 24 refers to a tension standard that is measured - but there is no disclosure of controlling it. Elsewhere there is disclosure that the diameter is controlled - but that is only one "value". There is no indication as to what standard is applicable. For example, are they limited to a US standard in 2003 (the time of filing) or is it limited to Korean standards in 2002? It is unclear whether one could copy applicant's invention exactly, and still not infringe merely by using the same values, but different standards therefore.

To look at it another way: It is unclear if "value" of line 5 should be interpreted as "values", or if "values" of line 6 should be interpreted as "(a) value".

The language "standard" is a word of degree' which is imprecise unless a definition or guideline has been set forth in the specification or the term is otherwise well known in the art. See Seattle Box Co. v. Industrial Crating and Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984). However, there is no evidence in application (nor

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is Examiner aware of any evidence) that the word "standard" has any art-recognized meaning. Nor is there any guidance or definition in the specification that would allow one of ordinary skill in the art to understand the meaning of the word.

Line 18: there is confusing antecedent basis for "the rollers" - clearly the fixing roller is a roller of the apparatus, it clearly cannot be larger than itself.

The term "offset" (directions) is indefinite as to its meaning. There is no mention of this aspect in the specification. It is unclear what they have to be offset from. Moreover, Applicant asserts that "offset" means not parallel. As per Hakoun 5382276, at page 4, lines 31-33, two things can be offset and parallel. Thus applicant's definition appears to contract what one of ordinary skill in the optical fiber art understands to be meant by "offset".

Claim 3 appears to present a claim interpretation ignores the tenet of claim construction that different words used in different used in different claims are presumed to have different meanings (which means that the "vertical direction" of claim 3 cannot be either of the "offset directions" of parent claim 1). *Karlin Tech. Inc. v. Surgical Dynamics, Inc.*, 177 F.3d 968, 971-72, 50 USPQ2d 1465 (Fed. Cir. 1999) (recognizing "the common sense notion that different words or phrases used in separate claims are presumed to indicate that the claims have different meanings and scope."). In other words: it is unclear if the vertical direction is a third direction. As indicated above, there

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is no mention of the "offset directions" - thus one would not be able to relate the vertical direction to it.

Claim 5: there is confusing antecedent basis for "said bracket" – it is unclear if it is referring to both brackets. It is also unclear if the transverse direction actually is different – as implied by the common sense tenet (above). The same applies to the connection of the last two lines of claim 5: Claim 1 already stipulated there is the connection.

Claim 10 is indefinite for the same reasons claim 1 is.

Claim 1 refers to an imaginary circle. One would not understand what is meant by this. It is unclear as to whose imagination the claim is limited to. For instance, one could say that they imagine a circle with 2 corners. How could one verify whether or not someone actually imagined such. Likewise, if an artisan with a limited imagination was unable to imagine such a circle, would he be permitted to copy applicant's invention? The claim limitations should be directed to structure. Also, would an infringing apparatus become non-infringing as soon as someone stops imagining the circle? Most notably, it is unclear whether applicant's Figure 3 fiber path represents an "imaginary circle".

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 3-6 and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Examiner could find no support for the newly claimed "at least two different offset directions" – either explicit or implicit. This is deemed to be a prima facie showing on failure to comply with the requirement. The burden is now on Applicant to show the requirement is complied with, or to amend the claims so that they comply.

There is no support for the limitation regarding the imaginary circle.

Response to Arguments

Applicant's arguments filed 01 December 2007 have been fully considered but they are not persuasive.

It is argued that it is clear that R2 in Figure 3 is an imaginary circle. Examiner would never imagine it to be a circle - except perhaps in a gravity- free environment. Examiner imagines that if the fiber had any looseness, that it would sag away from a circle. Examiner understands that it is somewhat like a circle, but Examiner assumes that such does not read on "imaginary circle".

Applicant asserts a definition for "offset". Applicant refers to a dictionary definition ("placed at an angle..."), but does not provided any evidence to support the

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assertion. Examiner's dictionary does not report any definition for 'offset' that refers to an angle. Thus it is assumed that applicant's definition is not a widely-held definition. It is well understood that an applicant can provide an atypical definition - as long as it is clearly, deliberately and precisely set forth in the disclosure during the initial application. It well accepted that an applicant cannot pick and choose definitions in the middle of prosecution.

The specification must clearly set forth the definition explicitly and with reasonable clarity, deliberateness and precision. *Teleflex Inc. v. Ficosa North America Corp.*, 63 USPQ2d 1374, 1381 (fed. Cir. 2002), *Rexnord Corp. v. Laitram Corp.* 60 USPQ2d 1851, 1854 (fed. Cir. 2001) and MPEP 2111.01.

Most importantly, applicant's unsupported definition refers to "not parallel". See the above rejection as to why one of ordinary skill would understand offset to encompass parallel items.

It is argued that Yoshida does not teach the rollers are independently mounted on different brackets. This appears to be true. However, such would have been obvious for the reasons of record.

It is argued that Examiner has failed to indicate anywhere in the art where there is a suggestion to use two separate brackets. Whereas Examiner did not point to a suggestion in the prior art, such is not really a failure, because Examiner did not attempt to do so, nor is Examiner required to do so. Examiner has provided various motivations. For example, starting on page 5 of the 3/8/07 Office Action. Nevertheless, art is now provided to so show it is a known and advantageous mechanical arrangement.

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As indicated by the Supreme Court in KSR vs. Teleflex:

When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under §103.

When two wheels need to be mounted, and brackets are used, there is only a finite number of solutions: one bracket for both, or one bracket per wheel. It is of ordinary skill and common sense to use two brackets rather than one.

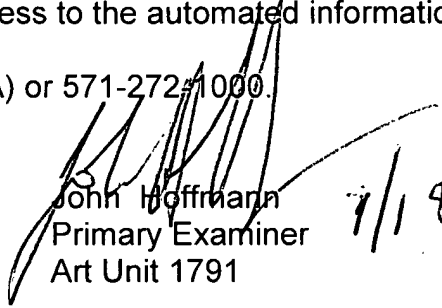
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


John Hoffmann
Primary Examiner
Art Unit 1791

7/18/08

jmh